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09/550,324	04/14/2000	John Slaby	491.040US1	8731

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EXAMINER
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POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 09/09/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/550,324

Applicant(s)

SLABY ET AL.

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 69-135 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 69-135 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *see attached office action*.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 20 June 2003 have been fully considered but they are not persuasive. The following is a listing of the reasons they are not persuasive.
2. The examiner withdraws the USC 112 rejections in light of the recent amendment.
3. Applicant charges that the examiner does not show configuration data, and that the X.25 packets do not constitute configuration data. Applicant further charges that Farese does not expressly disclose "configuration function for the apparatus" nor does it disclose "determination of configuration data at the configuration system... for transmission to the apparatus."
4. Applicant also charges that the examiner does not show sending unique information from the apparatus to the remote system. He further submits the failure to show that "configuration system determines configuration data for the communication apparatus in dependence upon the unique identification information" (Page 25, line 9-10), a limitation amended to claim 69.
5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "configuration system determines configuration data for the communication apparatus in dependence upon the unique identification information" (Page 25, line 9-10)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). This limitation was added only to claim 69 and is not present in any other independent claim. Thus, said argument is applicable only to claim 69.

6. Regarding the other arguments, it is necessary to understand the use of Farese. Farese teaches a gateway (ISDN Central Office w/Switch) that rests between a remote user and a remote host computer (Fig. 1) for the purpose of setting up the connection AND for changing that connection under certain circumstances. The primary configuration centers on the usage of B channels – if any – to gain certain advantages such as increased bandwidth and the connection of circuit switching to packet switching networks (col. 1, lines 20-23, 45-50). This certainly falls under configuration data as currently drawn in the claims, and if the applicant disagrees, he may wish to consider adding limitations to clarify this issue. Because packet switching and circuit switching each has advantages and disadvantages (col. 2, esp. lines 5-7), it would be beneficial to switch from one to the other without breaking the connection (col. 5, lines 1-15 and 25-31). The ISDN switch uses this configuration data, received from the remote host (col. 7, lines 5-10), to configure itself at that point in time, both to initialize the connection and to change the connection without disconnecting (col. 6, line 35 – col. 7, line 5). For more detail, the applicant is pointed to col. 7, lines 15-65. The applicant initially showed that said information was included in X.25 packets, which is the normal way to communicate such changes over this network (col. 8, lines 19-30). For more information regarding the use of these packets, the applicant is pointed to col. 13, lines 40-65, and col. 14, lines 15-20.

7. As shown previously, the user sends through the apparatus to the remote host computer login authentication information (col. 21, lines 10-27), which fulfills the passing of unique information as currently drawn in the claims for which a narrowing of the claim term is necessary to overcome this rejection. The apparatus also sends information regarding the application to be used by the user at any given time, for which the remote system automatically

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sends configuration data, based on this data, to change the apparatus configuration mid-connection (col. 7, lines 5-10). Further, the choice of connection is based on the level of configuration paid by the user, in light of the available data, (col. 14, lines 15-57), a setup that is well known in the art.

8. In response to applicant's argument that Ashton is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ashton teaches a management system for monitoring the results of communication data changes and the status of a changing network. Therefore, it is proper to use Ashton as a reference. Further, the primary purpose of Ashton is to show the development of a monitoring system, which Farese would be motivated to develop.

9. A similar rebuttal is made in regards to Bhatia. Further, the primary purpose of Bhatia is to show the combination of a variety of different communication systems, which Farese would be motivated to develop.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 69-71, 75-78, 80-88, 91, 92 are rejected under 35 U.S.C. 102(e) as being anticipated by Farese et al. (4,996,685).

12. For claim 69, Farese teaches a method (see abstract) of remotely configuring communication apparatus (col. 1, lines 10-16) for communication over a network to access a service (Fig. 1), the method comprising the steps of:

- a. Connecting said communication apparatus (Fig. 1, #30) to said network (Fig. 1, #35);
- b. Said communication apparatus automatically communicating with a remote configuration system over said network (Fig. 1, #50) using initial configuration data (Fig. 4, #430);
- c. Said communication apparatus transmitting unique identification information to said configuration system (Fig. 4, #490);
- d. At said configuration system determining configuration data for said communication apparatus (Fig. 4, #490, and Fig. 5, #503-507);
- e. Transmitting said configuration data to said communication apparatus (Fig. 5, #503-507);
- f. Storing said configuration data received from said configuration data in storage means in said communication apparatus (Fig. 6, #620-630);
- g. Controlling subsequent communications by said communication apparatus over said network using the stored configuration data (Fig. 6);
- h. Transmitting subsequent configuration data to said communication apparatus automatically from said configuration system (Fig. 4-7);

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i. Storing said subsequent configuration data in said storage means (Fig. 7, #730-740); and

j. Controlling subsequent communications by said communication apparatus over said network in accordance with the stored subsequent configuration data (Fig. 6 and 7).

13. As for claim 70, Farese also teaches a user (Fig. 1, #20) that initiates the process (Fig. 2, #213). Claim 71 is drawn to the use of a permanently open control channel associated with a plurality of data/voice channels (col. 1, lines 20-45).

14. For claims 75-78, Farese teaches that the network connects a LAN (Fig. 1, #60) to an ISDN line (Fig. 1, #25 and #35) that has a data channel and a plurality of bearer channels (col. 1, lines 27-46).

15. Claim 80 is drawn to a means implementation of many of the limitations in claim 70. If claim 70 is rejected, so is claim 80.

16. As for claims 81-83, Farese teaches that there is a dedicated data channel (D channel) for receiving configuration data (col. 8, lines 19-22).

17. Claims 84-86 are drawn to processing means that implement the limitations drawn in claims 72-74, respectively. If claims 72-74 are rejected, then claims 84-86 are also rejected for the reasons above.

18. As for claims 87 and 88, Farese teaches that the user I/O is a software program (Fig. 2A, #213).

19. As for claims 91 and 92, Farese teaches the encoding of the unique identification information (col. 21, lines 14-17) and the decoding of the configuration data (col. 21, lines 40-

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65). Examiner notes that encode and decode are not necessarily synonyms for encrypt and decrypt.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 72-74, 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91, 92 above, and further in view of Ashton et al. (6,181,679).

22. For claims 72-74, Ashton teaches the monitoring of such a network in real time (Fig. 4) and the processing of the information (Fig 9) into a summary report (Fig. 10). This report is then sent to the network manager (col. 2, lines 20-34), which could be the provider or the user as currently drawn in the claims. At the time the invention was made, one of ordinary skill in the art would have recognized that the network in Farese requires such a monitoring system (col. 2, lines 14-20).

23. As for claim 90, Ashton teaches that the information is gathered and processed using machine independent instructions for output to said user (col. 16, lines 53-56). At the time the invention was made, one of ordinary skill in the art would have kept the system machine independent in order to support a wider variety of machines.



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24. Claims 79, 89, 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91, 92 above, and further in view of Bhatia et al. (6,118,768).

25. As for claims 79 and 93, Bhatia teaches a connection of a POTS line (col. 15, lines 25-53). At the time the invention was made, one of ordinary skill in the art would have connected such a line to Farese in order to attach telephone equipment (Fig. 1, #20 and #25).

26. As for claim 89, Bhatia also teaches the use of a web server (Fig. 18 and 19). At the time the invention was made, one of ordinary skill in the art would have used a web server as a means of processing (col. 5, lines 1-10) as this was a standard method of I/O communication.

27. Claims 94-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese, Ashton, and Bhatia.

28. Claims 94-104 are drawn to a communication apparatus that implements the method drawn in claims 69, 80-82, 84-86, 88, 90-92, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 69, 80-82, 84-86, 88, and 90-92 are rejected, then claims 94-104 are also rejected for the reasons above.

29. As for claims 105-109, Farese teaches that the configuration data is selected based on the unique identification information, the previously gathered and stored user information, and the requested level of service (Fig. 4-7).

30. Claims 110-112 are drawn to a communication apparatus that implements the method drawn in claims 90-92, respectively. The prior art teaches that a system implementation is

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functionally equivalent to the underlying method. Therefore, if claims 90-92 are rejected, then claims 110-112 are also rejected for the reasons above.

31. Claim 113 is drawn to a system implementation of claims 69 and 75. Claim 114 is drawn to a system implementation of claims 73 and 85. Claim 115 is drawn to a system implementation of claims 74 and 86. Claims 116-120 are drawn to a system implementation of claims 87-90, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 90-92 are rejected, then claims 110-112 are also rejected for the reasons above.

32. Claim 121-126 is yet another system implementation of claims 69, 85, 72, 88, 90, 105, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 69, 72, 85, 88, 90, and 105 are rejected, then claims 121-126 are also rejected for the reasons above.

33. Claims 127-129 are drawn to an independent method form of claims 72-74, respectively. If claims 72-74 are rejected, then claims 127-129 are also rejected for the reasons above.

34. Claim 130 is a system means claim for part of claim 69. Claim 131 is a word for word copy of claim 130, and must be cancelled. Claims 132, 133 and 135 are system means claim for other parts of claim 69. Claim 134 is a word for word copy of claim 133, and must be cancelled. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 69 is rejected, then claims 130-135 are also rejected for the reasons above.

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***Conclusion***

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703)305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

  
ROBERT B. HARRELL  
PRIMARY EXAMINER

MHP  
02 September 2003